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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/194,796	12/01/1998	PETER JOHN HULME	S1022/8152	3615

7590 06/14/2006

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EXAMINER	
ZIMMERMAN, BRIAN A	
ART UNIT	**PAPER NUMBER**
2612	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/194,796	HULME, PETER JOHN	
	Examiner	Art Unit	
	Brian A. Zimmerman	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 23-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 23-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Status of Application

In response to the applicant's response received on 3/13/06. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 1,23-41 are unpatentable for the reasons set forth in this office action:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

1. Claims 1,23-41 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1,32 and 36 have been amended to include a limitation such that the second control signals are sent to from the first apparatus to the second apparatus without first transmitting the second control signals to the first remote control device. Support for such a negative limitation cannot be found in the specification as originally filed. The lack of a disclosure of a specific element is insufficient support for claiming that the element (or feature) cannot exist.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1,23-25,28,32,33,41 rejected under 35 U.S.C. 103 as being clearly obvious in view of Goldstein (5410326) and either Levine (5123046) or Young (5151789).

Goldstein shows a video display device (including elements 6,9) that transmits database information to a remote controller 5 to program or modify the control database 90,91 in the remote controller. See col. 18 lines 14-19. The video display device receives the programming information from a central station in the video system, using the VBI portion of the video signal from the central station. See col. 18 lines 50 to 61. The video display device stores the information it receives from the central station in the memory 143,144, prior to sending the information to the remote controller. Goldstein includes a user initiation option so the user can initiate the programming of the remote controller. See figs 1-9. Goldstein shows that the programming signals can be stored on a video tap and processed by a video player. The remote controller, once reprogrammed, can be used to operate entertainment component, namely a VCR 7 or stereo receiver 8. See figure 1. Goldstein shows the ability to download multiple command sets, thereby teaching the receiving of third control signals.

In analogous art, Young and Levine both teach a remote control system that downloads control commands where the second control signals are sent to from the first apparatus to the second apparatus without first transmitting the

second control signals to the first remote control device. See Young element 54 that transmits commands from the first apparatus (24) to a second apparatus (12) without sending the commands first to the remote controller (20). See Levine element 40 that transmits commands from the first apparatus (12) to a second apparatus (10) without sending the commands first to the remote controller (34). This provides a more automated control system that requires less involvement of the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the control concept taught by Levine and Young in the Goldstein system to reduce the operating burden of the user.

3. Claims 26,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein (5410326), Levine (5123046) and Young (5151789) as applied to claim 1 above, and further in view of Miyagawa (4989081).

In an analogous art, Miyagawa shows a system where a first apparatus is used to control a plurality of second apparatuses, and the plurality of second apparatuses include a sound system 16 and a home automation system 23. This permits the user to control as many systems/subsystems with one controller thus increasing the efficiency of the single remote control. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the home bus technique taught by Miyagawa in the Goldstein system in order to increase the usefulness of the remote control system.

4. Claims 29,30,31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein (5410326), Levine (5123046) and Young (5151789) as applied to claim 1 above, and further in view of Mills (6088355).

In an analogous art, Mills shows a cable decoder, which is generally associated with the image receiving circuit. This cable decoder of Mills is programmable. Mills can program the device using a smart card or signals received from the broadcast signal. See col. 11 lines 13-54 and col. 9 lines 9-40. The examiner is aware that there are many methods of programming command data into devices. Here Mills shows two that are used in the art of Television systems. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the programming technique taught by Mills in the Goldstein system in order to provide easy programming of the system.

5. Claims 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein (5410326), Levine (5123046) and Young (5151789) as applied to claims 1 and 32 above, and further in view of Geiger (508534).

In an analogous art, Geiger shows a remote control system with first and second apparatuses, where the first apparatus sends control signals to the second apparatus in response to signals received from a remote controller. Geiger also shows a further remote controller, which can be used to control the first apparatus. This shows that each apparatus can have a dedicated remote controller in addition to the system's "universal" remote controller. Therefore, it

would have been obvious to one of ordinary skill in the art at the time of the invention to have used the multi-"remote controller" technique taught by Geiger in the Goldstein system in order to allow increased control of the remote control system.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

The applicant points to page 10 lines 13-17 for support of the limitation rejected as new matter under 35 USC 112 first paragraph. This section of the specification corresponds to paragraph 54 of 2002/0097165, which is repeated verbatim herin:

> [0054] Also according to the present invention, the transmitter block TX of the STE 10 transmits control signals CS5 that are used to control the other apparatus 20, 30 and 40. Alternatively, the STB could control the other physically connected apparatus 20 and 30 via the cable.

This section of the specification does not recite transmitting control signals to the control apparatus without first transmitting the control signals to the remote control device as argued by the applicant.

The applicant points to page 14 lines 23-32 for support of the limitation rejected as new matter under 35 USC 112 first paragraph. This section of the

specification corresponds to paragraph 69 of 2002/0097165, which is repeated verbatim herin:

> [0069] When the microcontroller .mu.C identifies a remote control signal from remote control device RC1 that corresponds to a RC1 reference remote control signal it must firstly determine if the received signals or codes are associated with the STB 10 or with other apparatus. If the remote control signals received from remote control device RC1 are associated with the STB 10 then the microcontroller of the STB 10 is operated in accordance with the received signals or codes. If the RC1 received remote control signals are not associated with the STE 10 then the microcontroller of the STB 10 has to retrieve, from memory MEM, the stored remote control signals or codes to which the RC1 received signals or codes correspond. The microcontroller .mu.C then outputs, via the transmitter block TX of the STB, the non-RC1 reference remote control signals or codes that correspond to the received and stored RC1 remote control signals or codes, which operatively controls the corresponding apparatus.

This paragraph states (near the end) that the TX sends control signals which operatively control the apparatus. This section of the specification does not recite transmitting control signals to the control apparatus without first transmitting the control signals to the remote control device as argued by the applicant. The specification does not state that the signals are sent to the apparatus, merely that the codes are used to operate the control apparatus.

The applicant argues that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). In this case, the motivation articulated in the rejection repeated above is that the controller concept taught by Levin and Young would reduce the operating burden of the user, ie the device would function more automatically.

The applicant argues that the combination of Goldstein and either of Levine or Yang would not provide the claimed invention, but rather would provide the cable box with tuning capabilities (Levine) and remote control capabilities (Goldstein). The applicant has not point to any portion of the references that would support such a conclusion. Additionally, assume that the applicant is correct, because two references could be combined to show one combination is not evidence that the combination of the same references would not provide the claimed invention. In other words, the combination of A and B yielding C (as applicant contends) does not necessarily contradict the examiner's contention that the combination of A and B would yield D.

The applicant argues that the cable box of Levine does not include the use of signals received over broadcast medium. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here Goldstein is cited for teaching downloading of control signals received over broadcast medium.

The applicant argues that the remote of Goldstein does not teach these signals "without first transmitting the control signals to the remote controller.' First it is noted that this limitation does not apply to the third set of control signals. Additionally, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here Levine and Young teach this controlling of appliances without first transmitting control signals to the remote controller.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A. Zimmerman whose telephone number is 571-272-3059. The examiner can normally be reached on 7 am to 4 pm E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on 571-272-7308. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian A Zimmerman
Primary Examiner
Art Unit 2612

BZ